

## **REMARKS/ARGUMENTS**

Claims 68-92 are pending. Claims 68-92 are rejected. No claims are amended herein.

As discussed below, all of the claims are in condition for allowance. **But if after considering this response, the Examiner does not allow all of the claims, then the Applicants' attorney formally requests that the Examiner contact him to schedule and conduct a telephone interview before issuing a subsequent office action.**

### **Rejection of Claims 68-72, 74, 77-92 Under 35 U.S.C. § 103(a) Over Spagna et al. (U.S. Patent No. 6,587,837) And Further In View of Wyman (U.S. Patent No. 5,260,999)**

To establish a *prima facie* case of obviousness, an Office Action must demonstrate that all claimed elements are taught or suggested by proffered references. Section 2143.03 of the MPEP requires the “consideration” of every claim feature in an obviousness determination. To render a claim unpatentable, however, the Office must do more than merely “consider” each and every feature for this claim. Instead, the asserted combination of cited references must also teach or suggest *each and every claim feature*. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the references).

The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103, despite any recent revision to the Manual of Patent Examining Procedure (MPEP). For example, in *In re Wada and Murphy*, Appeal 2007-3733, the BPAI specifically states that:

“When determining whether a claim is obvious, an examiner must make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, “obviousness requires a suggestion of all limitations in a claim.” *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d

1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, “*there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).”

In sum, it remains well-settled law that obviousness requires **at least a suggestion of all of the elements of a claim**. See *In re Wada and Murphy*, citing *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

As currently presented, the present claims include elements that are not taught or suggested by *Spagna* and *Wyman*, either alone or in combination. The Applicant maintains the arguments advanced in the Response to Office Action submitted on June 4, 2009. In addition, the applicant advances additional arguments with this paper. For example, the presently cited prior art fails to teach or suggest “providing with a third computing device an option to modify at least one of the user attributes to qualify for a license, responsive to the determining finding that none of the plurality of licenses authorizes the requested use,” as recited in Claim 68.

### **Independent Claim 68**

As currently presented, the present Claim 68 includes elements that are not taught or suggested by *Spagna* and *Wyman*, either alone or in combination. Claim 68 reads:

A method for controlling access to digital content, the method comprising:

storing with a first computing device a plurality of licenses for authorizing use of the content, the **licenses being defined from a configurable rule that is based at least in part on at least one user attribute**;

receiving with a second computing device a request to use the content;

determining with the second computing device whether or not at least one of the plurality of licenses authorizes the requested use of the content;

responsive to said determination, allowing the requested use of the content if at least one of the plurality of licenses authorizes the requested use; and

**providing with a third computing device an option to modify at least**

**one of the user attributes to qualify for a license**, responsive to the determining finding that none of the plurality of licenses authorizes the requested use.

Accordingly, Claim 68 is directed to a method for controlling digital content, where user attributes can be modified to allow a user to qualify for access to the digital content. For example, “if the end-user has less than 18 years of age, the rights broker 142 can determine that if the end-user’s age attribute were changed, the rights broker 142 could grant the license to the consumer computer 120.” (Specification, paragraph [0084]) “This may be the case where, for example, an end-user has recently turned 18 years of age, but the sytem has not updated the consumer information yet.” (Specification, paragraph [0084])

The Office Action concedes that *Spagna* fails to teach or suggest providing an option to **modify at least one of the user attributes to qualify for a license**, and submits that *Wyman* col. 29, lines 11-68 does teach such an element. However, a close reading of *Wyman* reveals that *Wyman* merely teaches **modification of a license**, and not **modification of user attributes**.

For example, although *Wyman* col. 29, lines 11-12, recites that “the management interface can modify certain limited attributes,” the “attributes” indicated are not user attributes. Instead, the ‘attributes’ discussed in *Wyman* refer to license attributes.

Various portions of *Wyman* make this distinction clear. For example, *Wyman*, col. 8, lines 23-32 read:

Another important feature of one embodiment is a management interface which allows a license manager to **modify the license policy components of a license document** maintained by at a license server in its database. Usually the license manager can only make modifications that restrict the license policy components to be more restrictive than originally granted. Of course, the management interface is used to make delegations and assignments, if these are authorized. (Emphasis added)

Additionally, *Wyman*, col. 27, lines 4-15 read:

The management interface 33 is essentially the tools or mechanisms available to the license manager at the licensee's site to (a) load the various licenses received from issuers 25 into the database 23 and make them available for request allocation calls from the users, (b) remove the

licenses from the machine when expired, (c) to make delegations if permitted, (d) to make assignments, (e) to make reservations, etc. Whatever the license manager is allowed to do to modify the license for his special circumstances (within the original grant, of course), he does it by the mechanism of the management interface 33.

Applicants have reviewed *Wyman* and fail to find any reference to modification of user attributes to conform to a license. Accordingly, *Wyman* fails to teach or suggest **providing an option to modify at least one user attribute to qualify for a license**. Claim 68 is therefore allowable for at least this reason.

Additionally, *Spagna* also fails to disclose “licenses being defined from a configurable rule that is based at least in part on at least one user attribute.” *Spagna*, at the cited location, discloses that data in Usage Conditions can include copy restriction rules, the wholesale price, and any business rules deemed necessary. No further disclosure is provided related to licensing conditions. None of the listed “copy restriction rules, the wholesale price, or any business rules deemed necessary” relates to a user attribute. *Wyman* fails to remedy this teaching deficiency. Therefore *Spagna* and *Wyman*, either alone or in combination, also fails to teach “**licenses being defined from a configurable rule that is based at least in part on at least one user attribute**.” Accordingly, Claim 68 is also allowable for at least this reason.

#### **Dependent Claims 69-72, 74, 77-92**

Claims 69-72, 74 and 77-92 depend from Claims 68 and are therefore at least allowable by dependency. However, various elements of Claims 69-72, 74 and 77-92 are not taught or suggested by *Spagna* and *Wyman*, either alone or in combination.

For example, the Office Action submits that Col. 11, lines 8-17 of *Spagna* teaches the elements of Claims 69 and 70, namely wherein attributes include (1) a user’s age; and (2) wherein user attributes include user residence. These elements of Claims 69 and 70 are simply not taught in the cited portion of *Spagna* or elsewhere.

Additionally, Col. 11, lines 8-17 of *Spagna*, fails to address user attributes at all and instead simply relates to digital watermarks in content. Moreover a search of *Spagna* for the term ‘age’ reveals that age of user or any other such user attribute is not even addressed in *Spagna*.

In another example, the Office Action asserts that a user attribute of 'payment method' is taught in Col. 11, lines 8-17, and Col 4, lines 22-26. As discussed above, user attributes are not addressed in Col. 11, lines 8-17 and similarly, user attributes are not addressed in Col. 4, lines 22-26. Although, Col. 4, lines 22-26 may address payment generally, this portion of *Spagna* certainly does not teach or suggest that a user attribute can be defined as 'payment method' or the like, and modified to qualify for a license.

In yet another example, the Office Action asserts that elements of Claims 78-80 are taught by *Spagna*, such as (1) a requested use of copying to a CD; (2) a requested use of copying to a DVD; and (3) a requested use of copying to a hard drive. Specifically, the Office Action cited Col. 53 lines 11-16 of *Spagna*. Even if this section does teach or suggest use of CDs, DVDs, and a hard drive, it certainly does not teach or suggest that a requested use of media includes copying to any such storage mediums. In fact, the cited portion of *Spagna* simply relates to software elements being stored in such storage mediums, and does not address a request to copy content (e.g. audio or video) to such a storage medium.

Accordingly, because *Spagna* and *Wyman*, either alone or in combination, fail to teach or suggest all elements of Claims 69-72, 74 and 77-92, these claims are therefore in condition for allowance for at least this reason in addition to being depended upon allowable Claim 68.

**Rejection of Claims 73, 75, and 76 Under 35 U.S.C. § 103(a) Over Spagna et al. In View of Wyman And Further In View Of Eichstaedt et al. (U.S. Patent No. 6,108,645)**

Claims 73, 75 and 76 depend from Claim 68 and are therefore at least allowable by dependency because Claim 68 is allowable for the reasons discussed above. Applicants therefore request that the rejection of Claims 73, 75 and 76 be withdrawn.

In the event additional fees are due as a result of this amendment, the Commissioner is hereby authorized to charge any deficiency of fees submitted herewith, or credit any overpayment, to Deposit Account No. 07-1897.

If the Examiner believes that a telephone interview would be helpful, he is respectfully requested to contact the Applicants' attorney at (425) 455-5575.

Dated this 30th day of October, 2009.

Respectfully submitted,

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